

REMARKS

Claims 1-8 remain pending. Claims 9-16 were previously canceled in response to a restriction requirement. No claims are amended herein. The Office Action presents four interrogatories eliciting factual information. Each is presented and discussed below.

Requirements for Information

The examiner has requested information under 37 CFR 1.105. The examiner has not stated with particularity why the requirements have been made or how the information requested is necessary to the examination as specified by MPEP 704.14(a). Without knowing how the information is necessary for the examination, it is difficult to understand what information the examiner needs.

37 CFR 1.105(a)(1) authorizes examiners to make requirements for information where “reasonably necessary”. The criteria of reasonable necessity is generally met where the invention is in a new area of technology or where a lack of relevant prior art justifies asking the applicant for information relevant to the determination of patentability (MPEP 704.11). The present invention relates generally to billing systems for telephone networks which is clearly not a new area of technology. Likewise, the assignee in this case does not have access to information necessary to a more complete understanding of the invention and its context (MPEP 704.11). Further, MPEP 704.11(b)(III) states that “it is rarely appropriate to require information because of a lack of relevant prior art after the first action on the merits.” The substantial burden placed on the assignee by these requirements is not clearly outweighed by the benefit to the examination of the application.

If the examiner cannot describe why the requirements have been made or how the information requested is necessary to the examination as required by MPEP 704.14(a), then the requirements should be withdrawn.

Improvements of the Subject Matter in Claim 1 Over the Wall Street Journal Article

The only attempt by the examiner to narrowly specify and limit the scope of the

requirement for information as required by MPEP 704.14 follows: “The information is required to identify products and services embodying the disclosed subject matter of receiving network information from the communication network into the billing system and identify the properties of similar products and services found in the *prior art*.” (OA, p. 2, emphasis added.)

37 CFR § 1.105(a)(1) states in part that “the examiner... may require the submission... of information as may be *reasonably necessary* to properly examine or treat the matter...” (emphasis added). MPEP 704.11 then defines reasonably necessary as “that necessary for finding *prior art* or for resolving an issue arising from the results of the search for art...” (emphasis added).

Based on the examiner’s own statement, 37 CFR § 1.105(a)(1), and MPEP 704.11, the requirement for information related to the Wall Street Journal article was requested in the context of prior art. Applicant respectfully notes that the priority date of the present application is September 17, 1998, which is *before* the Wall Street Journal article publication date of April 12, 1999. Thus, the Wall Street Journal article is not prior art with regard to the current claims and so is not reasonably necessary to properly examine the matter. Applicant, therefore, respectfully refrains from further discussion of this question.

Because the article is not prior art and the examiner has not stated with particularity why the requirements have been made or how the information requested is necessary to the examination, the information required to be submitted is unknown and/or is not readily available to the Applicant.

Methods Employed by Applicant for Receiving Third Party Information from Third Party Networks Prior to the Filing Date of this Application

The parent to this application has issued as patent Marchbanks, et al., number 6,266,401 (hereinafter “the ‘401 patent”). The ‘401 patent identifies “a need in the telecommunications industry for a billing system and methodology that can accommodate current and future telephony network service billing requirements” (‘401 patent, col. 1, lines 34-37). Further, the ‘401 patent states that “present telephony network billing systems are currently incapable of

accounting for new and standard services and features such that all charges for all services and features contracted by a customer, *including third-party services*, are presented in a single consolidated customer invoice” (‘401 patent, col. 5, lines 1-6, emphasis added).

The claims in the ‘401 patent provide a detailed description of a method for receiving third-party information from third-party networks. Applicant respectfully requests that the examiner refer to the ‘401 patent for satisfaction of this requirement. Prior to the ‘401 patent, it appears that there was no effective method employed for receiving third-party information from third-party networks. Accordingly, Applicant respectfully asserts that the information required to be submitted is unknown and/or is not readily available to the Applicant outside of the information contained in the ‘401 patent.

Examples of Third Parties and Third Party Networks in the Claims at Issue

One skilled in the art will recognize that a wide variety of third parties and third party networks are embodied in the present invention. The following examples are not intended to describe each embodiment or every implementation of the present invention. Examples of third parties and third party networks in the claims at issue may include other telecom service providers (e.g. voice and data) and non-telephony network service/equipment providers (e.g. paging and voicemail service providers). (Present Application, p. 7, lines 9-14.)

Names of Any Products or Services That Have Incorporated the Claimed Subject Matter

This request was made previously on page 2, paragraph 4 of the Office Action mailed July 17, 2006. It was appropriately and completely answered on page 5 of the Response to the July 17, 2006 Office Action (Requirements for Information) which was filed with the USPTO on September 25, 2006. Applicant respectfully refers the examiner to the previous answer.

CONCLUSION

Applicant submits that claims 1-8 are allowable, and thus respectfully requests their allowance.

Applicant believes no fees are due with respect to this filing. However, should the Office determine additional fees are necessary, the Office is hereby authorized to charge Deposit Account No. 210765.

Respectfully submitted,

/steven l webb/

SIGNATURE OF PRACTITIONER

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